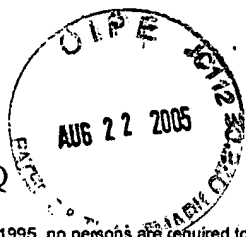


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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

31045-101

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on August 19, 2005

Signature

Typed or printed name

Jennifer Gaines

Application Number

10/613,741

Filed

July 3, 2003

First Named Inventor

John C. S. Koo

Art Unit

3728

Examiner

Stashick, Anthony

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/Joseph G. Swan/

Signature

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34

August 19, 2005

Date

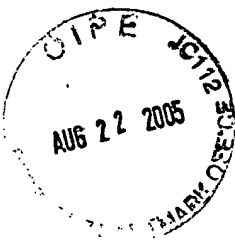
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Appellant's Pre-Appeal Conference Remarks

Claims 1-3, 5, 11, 12, 19, 20 and 24-29 stand rejected under 35 USC § 102(b) over U.S. Patent 4,356,643 (Kester); claim 4 stands rejected under § 103(a) over Kester in view of U.S. Patent 6,782,642 (Knoche); claim 6 stands rejected under § 103(a) over Kester in view of the last Patent 2,663,097 (Giese); claims 7, 8 and 10 stand rejected under § 103(a) over Kester in view of Official Notice; claim 9 stands rejected under § 103(a) over Kester in view of U.S. Patent 4,779,360 (Bible); claims 13-18 stand rejected under § 103(a) over Kester; and claims 21-23 stand rejected under § 103(a) over Kester in view of U.S. Patent 5,276,981 (Schaffer).

Independent claim 1 is directed to a shoe in which the bottom surface, which is adjacent to the ground in normal use, has a plurality of indentations, with lower extending portions between such indentations. An example is set forth in Figure 4, which shows the cross-section of a portion of a shoe's insole and outsole, having indentations 52 and lower extending portions 54 between them. See, e.g., page 12 line 24 through page 13 line 2. A sole forms at least a portion of the bottom surface, and an upper portion extends above the sole. A plurality of small particles is bonded to at least some of the lower extending portions (e.g., portions 54), but at least a portion of each of the plurality of indentations (e.g., indentations 52) is not coated with such small particles.

The foregoing combination of features is not disclosed by the applied art. In particular, Kester does not disclose at least the feature of: a plurality of indentations and lower extending portions between them, with a plurality of small particles bonded to at least some of the lower extending portions, but with at least a portion of each of the plurality of indentations not being coated with such small particles.

In the Office Action, the asserted particles used for Kester's shoe are the individual fibers 18 in Kester's friction pad 15. However, those particles are not in fact bonded to Kester's lower extending portions 14, but instead are woven through Kester's backing liner 16. See, e.g., column 2 lines 6-10 of Kester. The backing liner 16 then is bonded to the underside of the sole and heel using adhesives. See, e.g., column 2 lines 16-19 of Kester.

Moreover, there is absolutely no indication in Kester that any portion of Kester's indentations are not coated with the particles. In this regard, the Examiner correctly notes that Kester discloses a shoe having a plurality of indentations with lower extending portions 14 between them. However, in Kester the friction pad 15 (which includes the asserted particles 18) is applied to the entire front and heel portions of the shoe's bottom surface, as shown in Figure 2 of Kester. That is, with respect to the application of the particles 18, there is absolutely no distinction between Kester's lower extending portions 14 and the indentations between them.

The Office Action asserts that Figure 5 shows that feature that at least a portion of each of the plurality of indentations is not coated with the small particles, specifically pointing to the portions of backing liner 16 between particles 18. However, as set forth, e.g., at column 1 lines 37-42 of Kester, Figure 5 of Kester merely shows Kester's friction pad 15 in isolation. It shows nothing at all about how the particles 18 are attached in any manner whatsoever to Kester's shoe.

To the contrary, as already noted above, Kester discloses that the friction pad 15 covers the entire front and heel parts of the shoe. Kester provides no distinction at all between the lower extending portions 14 and the indentations between them.

For the foregoing reasons, independent claim 1 could not have been anticipated by Kester.

The other pending claims depend from independent claim 1, discussed above, and are therefore believed to be allowable for at least the same reasons. Each also defines an additional aspect of the invention, which further distinguishes it from the applied art.

For example, dependent claim 4 recites the further feature that the small particles are bonded to the at least some of the lower extending portions by embedding the small particles directly into the bottom surface using at least one of heat and pressure. In the Office Action, Knoche is cited as showing this feature of the invention. However, Knoche is only understood to discuss the embedding of a mesh layer into a shoe's sole. It does not appear to say anything at all about directly embedding small particles into the bottom surface of a shoe using heat and/or pressure. For this additional reason, claim 4 would not have been obvious in view of any permissible combination of Kester and Knoche.

Dependent claim 6 recites the further feature that the small particles comprise a fabric material and have been applied using a flocking technique. In the Office Action, it was asserted that it would have been obvious to use Giese's flocking to attach Kester's particles to the outsole of Kester's shoe "to gain traction, as taught by Giese". However, Giese does not appear to say anything at all about using his flocking technique to increase traction. Rather, Giese only appears to cite the advantages of attractiveness and wear quality. See, e.g., column 1 lines 11-26 of Giese. Accordingly, there would not appear to have been any motivation to combine the teachings of Giese with those of Kester.

Based on the foregoing remarks, withdrawal of the current rejections is respectfully requested.